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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,561	01/17/2001	Kareem I. Batarseh	3731-002	5927

7590 10/22/2003  
KILYK & BOWERSOX, P.L.L.C.  
53A Lee Street  
Warrenton, VA 20186

EXAMINER

CHOI, FRANK I

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 10/22/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application N .

09/761,561

Applicant(s)

BATARSEH ET AL.

Examiner

Frank I Choi

Art Unit

1616

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): 112 2<sup>nd</sup> paragraph rejections over 1-4,7-16,18-30.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☒ The proposed drawing correction filed on 02 October 2003 is a) ☐ approved or b) ☒ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☐ Other: \_\_\_\_\_



**S. MARK CLARDY**  
**PATENT EXAMINER**  
**GROUP 1200 1616**

Continuation of 2. NOTE: The claims are amended to indicate that the complex is a solid in aqueous solution which was not previously set forth in the claims during the course of prosecution. As such, the same would require further consideration and/or search.

Continuation of 5. does NOT place the application in condition for allowance because: Examiner acknowledges the proposed amendment to the drawings, however, the data values are still not clearly legible. Since one would have to compare spectrum of a given compound to the spectrum in the figures in order to determine whether it falls within the scope of the claim, the drawings must be legible so that a comparison can be made. With respect the prior art rejections, Examiner again reiterates that the rejection is based on 102/103 inherency which involves a different standard than obviousness under 103. Applicant argues that a person skilled in the art would not go below a pH of 3. However, Applicant has not shown that "about 2" excludes a pH of below 3. Assuming Applicant's arguments are valid, i.e. that glycine and aspartic acid only form complexes in basic solutions at a pH greater than 6.5 and that the concept holds true for methionine, then the claims cannot be enabled for glycine, aspartic acid or methionine. The disclosed preparation processes and prior processes appear to be the same, however, Applicant argues the result is different. Since there is no apparent difference in the processes, the process must be specific to the components used. As such, the claims are not fully enabled as they are greater in scope and Applicant has argued that it is impossible for some amino acids to form complexes at the claimed pH range. Glycine and methionine are specifically claimed by Applicant. With respect to the limitation "disinfectant" the term is not defined in the claim and Applicant has no shown that the prior art composition does not contain a "disinfectant". Examiner acknowledge Applicant's arguments with respect to claim 9, however, neither claim 9 nor the other methods claims for controlling biofouling and the like were not rejected. With respect to Sanchez, Applicant cites to page 33, paragraph 4, lines 1-7. Examiner is unsure what Applicant is referring to as neither the English translation nor the French language reference have a page 33. Assuming, Applicant's arguments are valid then the claims are not enabled for phenylalanine, alaine or serine for reasons similar to above.